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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,968	07/26/2006	James L. Meisel	60045(50177)	5803
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EXAMINER PORTER, RACHEL L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,968

Applicant(s)

MEISEL ET AL.

Examiner

RACHEL L. PORTER

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-16, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This communication is in response to the preliminary amendment in the application, filed 2/20/07. Claims 1-16 and 24-25 are pending. Claims 17-23 have been cancelled.

Information Disclosure Statement

2. The IDS filed 4/20/05 has been considered by the Examiner.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. 101 as covering non-statutory subject matter. See *In re Nuijten*, 500. F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter).

Furthermore, in the instant case, applicant's specification, explains: "computer readable medium shall be understood to mean any article of manufacture that contains data that can be read by a computer or a carrier wave signal carrying data that can be read by a computer." (par.16)

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. 101 by adding the limitation "non-transitory" to the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Filteau et al (US 20020188896 A1).

[claim 10] Filteau discloses a method for generating patient communication from a clinician using a computer for facilitating interaction between a user and a client, comprising:

- providing a repository of snippets including patient text and providing a database; (par. 46,49-50)
- displaying information from said database regarding a selected patient using said display device; (Figures 7A-7B)
- receiving via an interface a selection of at least one snippet from said repository of snippets; (Figure 7B, par. 82)
- displaying at least a portion of said selected snippet using said display; (Figure 7A-7B, par. 82)
- enabling interaction with said snippet using said interface to select at least a portion of said snippet; and (par. 82-83)
- generating patient communication based upon the interaction with said snippet. (par. 53-54; par 84-86; Figure 8A—patient communication because it has the information of a patient)

[claim 11] Filteau discloses the method of claim 10, wherein said interaction with said snippet includes selecting items from a menu. (par. 55-61, 80-81—menus use to retrieve information/text)

[claim 12] Filteau discloses the method of claim 10, wherein said interaction with said snippet includes selecting or deselecting a text portion.

[claim 13] Filteau discloses the method of claim 12, wherein said selecting or deselecting includes utilizing a checkbox or drop-down menu. (par. 55-61)

[claim 14] Filteau disclose the method of claim 10, wherein said interaction with said snippet includes inserting one or multiple words at a predefined location. (par. 84-85-- templates used and HTML documents, data entered at specific locations)

[claim 15] Filteau discloses the method of claim 10, wherein said interaction with said snippet includes importing data from said database. (par. 85)

[claim 16] Filteau discloses the method of claim 15, wherein said importing data from said medical database includes displaying one or more of the following: EKG traces, an X-ray image, a CT image and a tangible manifestation of a test result. (par. 26, 37-- diagnostic image images viewable)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,2-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filteau et al (US 20020188896 A1) in view of Garcia (US 5065315)

[claim 1] Filteau discloses a method for providing medical communications to patients comprising the steps of:

- receiving first data relating to a test from a laboratory via electronic data interchange; (par. 8, 25—diagnostic findings)
- retrieving second data relating to a patient associated with the first test data; (par. 45—acquire patient information)
- selecting a medplate based upon the first test data; (par. 41, 43—selecting template for reporting)
- auto populating the medplate based upon the first test data and the second patient data; (par. 48-49—entering patient data and diagnostic findings into according to rules)
- applying at least one rule to select default textual fragments based upon the first test data; (par. 41, 46-- new diagnostic finding and its associated text can be provided)
- providing alternative textual fragments within the medplate; (par. 50—text editor allows changes in textual context; has spell check capacity and with a knowledge base that includes medical terminology associated with the anatomy of interest in the present study).
- presenting the medplate for review; (Figure 8A; par. 50-51)
- receiving selection input regarding use of the default and alternative textual fragments to modify the medplate; (par. 51-52)
- automatically generating a correspondence based upon the modified medplate; and (Figure 2 (140); par 53—rendering the report)
- providing the correspondence (par. 53-54)

Filteau discloses a method of generating a report as described above but does not expressly disclose providing the report to the patient. Garcia discloses a method in which a patient diagnostic report is generated for the patient. (abstract, col. 8, lines 50- col. 9, lines 3--discharge instruction document).

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Filteau with the teaching of Garcia to provide a diagnostic report document to the patient. One would have been motivated to include this feature to ensure that the patient is properly apprised any potential health problems associated with abnormal diagnostic readings and what future steps should be taken. (Garcia: col. 8, lines 50- col. 9, lines 3)

[claims 2, 3] Filteau discloses method, wherein the at least one rule is an inclusionary rule and wherein the at least one rule is an exclusionary rule. (par. 41, par 46, 48)
[claim 4] Filteau discloses a method 1, wherein the default and alternative textual fragments include check boxes, blank fill in boxes and boxes with pull-down menus. (par. 83)

[claim 9] Filteau discloses a computer-readable medium whose contents cause a computer system to perform a method for generating physician to patient communication, the computer system having a server program and a client program(Figure 2; par. 39), with functions for invocation by performing the steps of:

- receiving first data relating to a test from a laboratory via electronic data interchange; (par. 8, 25—diagnostic findings)
- retrieving data relating to a patient associated with the first test data; (par. 45—acquire patient information)
- selecting a medplate based upon the first test data; (par. 41, 43—selecting template for reporting)
- auto populating the medplate based upon the first test data and the second patient data; (par. 48-49—entering patient data and diagnostic findings into according to rules)
- applying at least one rule to select default textual fragments based upon the first test data; (par. 41, 46-- new diagnostic finding and its associated text can be provided)
- providing alternative textual fragments within the medplate; presenting the medplate for review; (par. 50—text editor allows changes in textual context; has spell check capacity and with a knowledge base that includes medical terminology associated with the anatomy of interest in the present study).
- receiving selection input regarding use of the default and alternative textual fragments to modify the medplate; (par. 51-52)
- automatically generating a correspondence based upon the modified medplate; (Figure 2 (140); par 53—rendering the report)
- and providing the correspondence (par. 53-54)

Filteau discloses a method of generating a report as described above but does not expressly disclose providing the report to the patient. Garcia discloses a method in which a patient diagnostic report is generated for the patient. (abstract, col. 8, lines 50- col. 9, lines 3--discharge instruction document).

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Filteau with the teaching of Garcia to provide a diagnostic report document to the patient. One would have been motivated to include this feature to ensure that the patient is properly apprised any potential health problems associated with abnormal diagnostic readings and what future steps should be taken. (Garcia: col. 8, lines 50- col. 9, lines 3)

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filteau and Garcia, and in further view of Joao (US 20010032099 A1)

[claim 5] Filteau discloses a method, further comprising the steps of storing a calendar date for an action, based upon the correspondence, (Fig. 8a--report includes a date), but Filteau does not expressly disclose automatically generating a reminder related to the action on the calendar date.

Joao discloses a healthcare method/system storing date information relating to medical treatments/procedures(appointments) (par. 268; Figure 11 A) and automatically generating reminders relating to the action on the calendar date. (par. 269) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the to modify the combined method of Filteau and Garcia with Joao to

generate reminders regarding follow-up medical appointments (i.e. automatically generating a reminder related to the action on the calendar date.) As suggested by Joao, one would have been motivated to include this feature to ensure that a proper treatment and/or procedure is performed on the patient, and/or to ensure that a subsequent treatment and/or treatments are performed as prescribed. (par. 31)

9. Claim 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filteau and Garcia, and in further view of Clark et al (US 6171112 B1) [claim 6, 7] Filteau and Garcia disclose the method of claim 1 as explained in the rejection of claim 1. However, Filteau and Garcia do not expressly disclose a method further comprising the step of requesting confirmation of receipt of the correspondence and the step of archiving the correspondence with a notation as to whether or not the confirmation of receipt was received.

Clark discloses a method include the step of requesting confirmation of receipt of a correspondence from a patient user (i.e. prompting the user to sign whether or not they received information regarding their procedure) and the step of archiving the correspondence with a notation as to whether or not the confirmation of receipt was received. (e.g. signature sheet is printed out and stored with patient record) (col. 25, lines 28-57) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Filteau and Garcia in combination with the teaching of Clark to request confirmation and record/archive whether the patient received a particular document. As suggested by Clark, one would have been

motivated to include this feature to establish an archivable record that the a patient has been presented with particular information, which can be retrieved and observed for later use. (col. 3, lines 45-55)

[claim 8] Filteau discloses a method , further comprising the step of providing an attachment with the correspondence, wherein the attachment is selected from the group consisting of: a laboratory requisition, prescription for ordering subsequent clinical tests, a prescription for a medication, a prescription for therapy, a portion of text describing information about subsequent clinical tests, test results, symptoms, health conditions, a prescribed medication, a prescribed therapy, a plurality of recommendations for lifestyle modification, screening, and interactions with health care providers, and a referral to a health care provider. (Figures 8b-8c--test results/screenings)

10. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filteau, in view of Crane et al US 5748907 A.

[claim 24] Filteau discloses a method comprising the steps of:

- providing a display device and an interface for facilitating interaction between a human and a processor, providing a repository of snippets including patient text, providing a database including patient data; (Figure 1, 7A)

- viewing information regarding a patient including at least one test result using said display device; (Figure 8A)
- selecting at least one snippet from said repository of snippets; (Figure 7B, par. 82)
- interacting with said snippet using said interface to select at least a portion of said snippet; (par. 82-83)

Filteau discloses the method as described. Filteau further discloses generating a patient communication (par. 53-54; par 84-86; Figure 8A—patient communication because it has the information of a patient) but does not expressly disclose sending said patient communication including a prescription to said patient.

Crane discloses a method including the step of automatically generating a prescription for a patient based upon the diagnostic results and provides instructions and the prescription to the patient. (col. 24, lines 40-45; col. 26, lines 36-46) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Filteau with the teaching of Crane to provide the prescription with the diagnostic report to the patient. One would have been motivated to include this feature to minimize the time patients spent waiting for treatment, and traveling running around to various, locations, testing facilities, to resolve health issues (col. 3, lines 1-10)

[claim 25] Filteau and Crane describe the method of claim 24, as explained in the rejection of claim 24. Filteau does not disclose providing a prescription.

Crane discloses a method wherein said generating the prescription for the patienti includes providing a security feature designed to prevent duplication of said prescription. (col. 24, lines 40-45; col. 26, lines 36-46) The prescription may be automatically transmitted to the pharmacy and linked to the user ID numbers for audit trail purposes. At the time of the applicant's invention, it would have been obvious to modify the method of Filteau with the teaching of Crane. One would have been motivated to include this feature to further streamline the healthcare process and saving the patient time, while also preventing prescription abuse.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Britton et al (US 7590932 B2); and Larrea et al (US 20030208490 A1)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rachel L. Porter/
Examiner, Art Unit 3626